

- D2*
- (i) a proximal end that carries a second coupling member that is detachably coupled to the first coupling member;
- (ii) a distal end;
- (iii) said helical vasoocclusion coil comprising a multiplicity of windings having a first diameter immediately adjacent [intermediate] said proximal end and said distal end; and
- (iv) said helical vasoocclusion coil being further wound into a second diameter smaller than said first diameter at said proximal end and at said distal end, whereby said distal end and the first coupling member at said proximal end are positioned radially inwardly of said immediately adjacent first diameter, such that the coil acts to occlude a vessel or a cavity within a vessel when placed within said vessel or cavity.
-

Applicants have amended claims 1 and 4 solely to clarify the invention. No new matter is added.

REMARKS

35 U.S.C. § 103(a): Claims 1, 3 and 4

Claims 1, 3 and 4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent No. 3,204,410 to Heinke et al. ("Heinke et al.") in view of U.S. Patent No. 5,639,277 to Mariant et al. ("Mariant et al."). In support of the rejection, the Examiner states:

Heinke et al. disclose a coil (1) having proximal and distal ends that are radially inward relative to the center section. However, Heinke et al. do not disclose the detachable ends. Mariant et al.

teach of this element (see figure 14) in the same field of endedavor [sic] for the purpose of allowing proper placement of the coil. It would have been obvious to one skilled in the art at the time of the invention [sic] to have placed the attachment means taught by Mariant et al. onto the Heinke et al. device in order to allow proper and controlled placement of the coil.

Applicants respectfully disagree and submit that the Examiner has fallen short of making a *prima facie* case of obviousness.

A *prima facie* case of obviousness cannot be established absent some teaching, suggestion or incentive supporting the combination. Heinke et al. is directed towards a catheter-delivered wire coil which can be deformed upon hot working to assume "a knot-shaped configuration" to occlude cancer-feeding blood vessels. In each of the figures of Heinke et al., the extreme distal and proximal ends of the coils project beyond the diameter of their immediately adjacent coil winding. Nowhere in Heinke et al. is there any hint of a suggestion of the need to avoid injury to the vessel wall.

Nor is there any teaching or suggestion in Mariant et al. to do so (the Examiner is directed to Applicants' arguments posited on pages 4-5 of the Amendment mailed on March 20, 1998 for the parent application to the present case, Application Serial No. 08/736,896).

Furthermore, even when the combination of Heinke et al. and Mariant et al. is taken as a whole, such a combination does not suggest to one of ordinary skill in the art the device of claims 1, 3 and 4.

For these reasons, Applicants respectfully contend that the Examiner has not established *prima facie* obviousness.

Without prejudice to the foregoing, and strictly to expedite prosecution of the presently pending claims, Applicants have amended claims 1 and 4 to require the coil have a first diameter



immediately adjacent the proximal and distal ends and a second diameter smaller than the first diameter whereby the proximal end is positioned radially inwardly of the first diameter.

Applicants respectfully submit that the present rejection based upon 35 U.S.C. § 103(a) be withdrawn and pending claims 1 and 4 be allowed. As pending claim 3 depends from independent claim 1, Applicants respectfully submit that the present rejection as applied to claim 3 is also improper and request that it be withdrawn and allowed.

SUMMARY

Each matter of substance raised by the Examiner has been addressed. Applicants respectfully request the rejections for claims 1, 3 and 4 be withdrawn.

Should the Examiner have any additional requests or a desire to discuss the details of the invention in greater detail, he is invited to contact Applicant's attorney at the number listed below.

Respectfully submitted,



Dated: February 10, 1999

By:

William C. Revelos
Registration No. 42,101

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-5846
Facsimile: (650) 494-0792

